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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,766	01/19/2000	Veronique Mahe	ROC-17	8806

7590 07/14/2005

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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1618

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/483,766

Applicant(s)

MAHE ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-23 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-23 is/are rejected.
- 7) ☒ Claim(s) 35-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Examiner acknowledges receipt of amendment and remarks filed 04/26/05. Claims 1-17, 19-23 and 35-37 are pending.

Response to Amendment

The amendments filed 10/08/04 and 11/26/04 were non-complaint. However, the amendment filed 04/26/05 fails to show with markings in which deleted matter remains in the claims but is shown either by strikeout or by open and closed bracket to show the items that are deleted and any additions shown by an underline. However, the claims are examined with a reminder that the next submission should comply with the format for amending claims (37 CFR 1.121). Claims 4 and 11 are identified as being amended but there are no markings to indicate what is deleted and what is added.

Claim Rejections - 35 USC § 112

1. The rejection of claims 4, 11 and 24-37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn. However, other formal matters are pending in regards to the proper manner of making amendment (37 CFR 1.121).

Claim Rejections - 35 USC § 102

2. Claims 1-13, 15-17 and 19 remain rejected under 35 U.S.C. 102(b) as being anticipated by Fowler et al. (5,534,265).

Fowler discloses a cleansing composition comprising menthol, menthyl lactate, sodium lauryl sulfate, sodium laureth sulfate, cetyl dimethyl betaine, sodium cocoyl isethionate, glycerin,

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polyethylene glycols, fragrance, anti-oxidants, preservatives, polyquaternium- 10, glycerol, propoxylated glycerol, carboxymethyl cellulose and hydroxypropylcellulose; Fowler teaches a cleansing composition comprising 0.1% to 10% menthol and menthyl lactate (claims 1 and 2, column 2, lines 26-44; column 4, line 18 to column 5, line 32; column 6, line 62-46; column 9, lines 13-32; column 10, line 7 to column 12 line 26; column 19, lines 25-63). The comprising language of the instant claims permits the presence of other ingredients in the composition. In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of the prior art would have the recited ratio of menthol to menthyl lactate. In the claims, "not being irritating to sensitive parts of the human body" carries no patentable weight and a prior art composition that meets the limitation of the instant composition would inherently not irritate sensitive parts of the human body. Fowler meets the limitation of the claims.

Response to Arguments

3. Applicants' arguments filed 04/26/05 have been fully considered but they are not persuasive.

Applicants argue that Fowler provides a laundry list of materials without teaching or suggesting that the materials can be used together.

Contrary to applicants assertion, it is respectfully noted Fowler in claim 2 specifically states that the "composition further comprises from about 0.1% to about 10 % of material

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selected from ... menthol, ... methyl lactate, ... and mixtures thereof.” Thus in terms of a composition comprising menthol and menthyl lactate, Fowler discloses and suggests a mixture of the menthol and the menthyl lactate. The comprising language of the claims does not exclude the other ingredients listed by Fowler. Freshening cosmetic and personal cleansing are the intended uses of the composition. However, a personal cleansing composition can also be a cosmetic.

4. Claims 1-3, 15-17 and 21-23 remain rejected under 35 U.S.C. 102(a) as being anticipated by Koga (JP 10,231,238).

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract). In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of the prior art would have the recited ratio of menthol to menthyl lactate. In the claims, “not being irritating to sensitive parts of the human body” carries no patentable weight and a prior art's composition that meets the limitation of the instant composition would inherently not irritate sensitive parts of the human body. Thus, Koga meets the limitations of the claims.

Response to Arguments

5. Applicants' arguments filed 04/26/05 have been fully considered but they are not persuasive.

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Applicants refer to Koga's menthol and menthyl lactate as refrigerants and it is respectfully noted that these same refrigerants are the materials claimed by applicants and Koga discloses mixture of the two components; the disclosure by Koga that the menthol and menthyl lactate should be used with ethanol and isopropyl alcohol does not remove Koga as art because ethanol and isopropyl alcohol are not excluded by the claims but rather the comprising language of the claims allows for the presence of ingredients such as the alcohol. Since Koga discloses amounts of menthol from about 0.01% to about 2% and menthyl lactate from about 0.1 to about 10%, there is a point within that range that provides 3 times 0.01% say, and 10 times 0.01% and here a menthol amount of 0.1% and 1% and menthyl lactate of 0.3% and 10% satisfies the recited ratio and the prior art does not necessarily have to specifically state the ratio when the recited ratio reads on the disclosed range at one or more points on the range. The examples are exemplifications of some embodiments of disclosed inventions and the disclosure of the claimed invention is nonetheless a disclosure and anticipatory when the claims read on the disclosed invention.

Claim Rejections - 35 USC § 103

6. Claims 14 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 5,534,265). Claims 35-37 are included in this rejection and this new rejection is made because of the amendment to claim

Fowler discloses the instant composition but does not teach the amounts recited in claims 14, 18 and 20. It is within the purview of the person of ordinary skill in the art to formulate composition that have specific amounts of the various components that would provide a composition for cleansing the skin and hair. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made formulate a composition that comprises menthol and menthyl lactate according to the teaching of Fowler. One having ordinary skill in the art would have been motivated to formulate the skin or hair cleansing composition of Fowler using amounts that are expected to provide a composition that would yield non-abrasive personal cleansing composition.

Response to Arguments

7. Applicants' arguments filed 04/26/05 have been fully considered but they are not persuasive.

In response to applicants' argument that Fowler does not disclose the specific combination of menthol and menthyl lactate, it is respectfully noted that Fowler discloses the combination as stated above. That is, claim 2 of Fowler specifically states that the composition "further comprises from about 0.1% to about 10 % of material selected from ... menthol, ... methyl lactate, ... and mixtures thereof."

8. Claims 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is noted that the method claim involves applying the composition of claim 21 to the skin as a shower gel or foaming gel. Since the composition of Koga is a cosmetic, applying the composition to the skin would inherently cleanse and freshen the skin; shower gels and foaming gel are forms of cosmetic compositions.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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